

### REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 3, 7-8, 11, 13, 15, 18, 20, 23, 26, 29, 32, and 34-38 are pending, with 3 amended by the present amendment.

In the Official Action, Claims 3, 7, 8, 11, 13, 15, 18, 20, 23, 29, 32 and 34-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayward et al. (U.S. Patent No. 6,798,997, hereinafter Hayward) in view of Vallabh (U.S. Patent No. 7,054,832); and Claim 26 was rejected under 35 U.S.C. § 103(a) over Hayward and Vallabh in view of Benjamin et al. (U.S. Patent No. 6,113,208, hereinafter Benjamin).

Applicants note that the IDS of November 6, 2001 was only partially acknowledged. Applicants again request that all references cited in this IDS be formally acknowledged with the Examiner's initials.

Claim 3 is amended to more clearly describe and distinctly claim applicants' invention. No new matter is added.

Briefly recapitulating, Claim 3 is directed to a print apparatus consumable purchase system including, *inter alia*, a controller for displaying a status screen for representing consumption degree of a consumable used with the print apparatus on a display and displaying one of a plurality of options concerning a purchase mode of the consumable in a status screen and an option calling button for calling the plurality of options in the status screen. The plurality of options includes a delivery purchase option and a store purchase option represented by a delivery purchase button and a store purchase button.

Hayward describes an automatic supply ordering system for electronically ordering a consumable component or replaceable part in a marking machine. The system provides electronic identification of a condition of a replaceable component and automatically

electrically sends an offer to purchase a replacement part upon identification of a threshold condition.<sup>1</sup> Hayward includes a display screen that includes a “buy now” button that is activated when an ink level reaches a certain predetermined threshold.<sup>2</sup> However, as acknowledged in the Official Action, Hayward only discloses a buy now option and does not disclose a store purchase option as recited in Applicants’ Claim 3.

In Hayward, the server 40 may forward an order to a supplier local to the user's location or the server 40 may process the order and ship directly to the user. Server 40 knows the address of the user from the purchase order. With pre-arranged contracts with networks of office supply retailers and mail order houses, server 40 is kept aware of the level of inventory on hand at the retailer, and can confirm availability before sending the shipment order to the retailer.<sup>3</sup>

However, the Official Action (page 4, first paragraph) misconstrues Hayward. The cited portion of Hayward describes that using “cookie technology” developed for browsers, the application program of Hayward examines the cookies for office supply retailers that the user has already used for supplies (e.g., when the user buys supplies online from the retailer). Such retailer can become a preferred distributor for the manufacturer’s supplies. If accounts are established with the retailers that carry the desired part, the application program may inquire of the user at the time the user clicks on the “Buy Now” button whether the user want to order from the preferred retailer on account.<sup>4</sup> This description merely states that a preferred retailer may be identified to be a supplier. This description does not describe arranging for a store purchase or any other option. That is, Hayward is exclusively directed to ordering for delivery, and does not disclose or suggest a store option or any option other than ordering for delivery.

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<sup>1</sup> Hayward, Abstract.

<sup>2</sup> Hayward Figure 4, column 7, line 54 through column 8, line 12, column 8, lines 32-53.

<sup>3</sup> Hayward, column 8, lines 46-53.

<sup>4</sup> Hayward, column 8, lines 54-63.

Vallabh describes a method of selling merchandise, whereby a seller receives an order from a customer for a product desired to be picked up by the customer at a given location and preparing the product for customer pickup. However, Applicants submit there is no teaching, suggestion, or motivation, either explicitly or implicitly, in either reference to combine the store pickup feature of Vallabh with the delivery order of Hayward to arrive at Applicants' inventions recited in Claim 3. Thus, Applicants submit it is only through an impermissible hindsight reconstruction of Applicants' invention that the rejection of Claim 3 can be understood.<sup>5</sup>

In effect, the outstanding rejection does little more than attempt to show that parts of the inventive combination of Claim 3 were individually known in other arts and to suggest that such a showing is all that is necessary to establish a valid case of *prima face* obviousness. The PTO reviewing court recently reviewed such a rationale and dismissed it in *In re Rouffet*, 149 F. 3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) as follows:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. [emphasis added.]

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<sup>5</sup> MPEP § 2143.01 "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge of one of ordinary skill in the art."

There has been no such showing of those required reasons made in the rejection.

Accordingly, in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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